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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/036,231	12/24/2001	Charles W. Scouten	CT-DST-1	5266

7590 11/03/2004  
Patrick D. Kelly  
11939 Manchester # 403  
St. Louis, MD 63131

EXAMINER

WEBB, SARAH K

ART UNIT PAPER NUMBER

3731

DATE MAILED: 11/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/036,231

Applicant(s)

SCOUTEN ET AL.

Examiner

Sarah K Webb

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 31 August 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 9 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-19 and 21-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 8/31/04
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Claims 9 and 20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 8/31/04.

### ***Drawings***

2. Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.121(d)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

3. The abstract of the disclosure is objected to because it is too long. Applicant is reminded of the proper language and format for an abstract of the disclosure. The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. Correction is required. See MPEP § 608.01(b).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-8, 10-19, and 21-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,258,103 to Saracione in view of US Patent No. 6,416,520 to Kynast et al. and further in view of US Patent No. 4,819,195 to Bell et al.

Applicant points out in pages 2-3 of the reply filed 8/31/04 that the only difference between the Saracione device and the claimed invention is that Saracione fails to display all three signals from the reader heads on one display device that is not mounted on the manipulator. The reader heads of the Saracione device are inherently retrofitted onto the stereotaxic holder, as they are manufactured separately.

In lines 32-53 of column 11, Saracione describes the reader heads as being electronic digital scales that display a measured position, have greater resolution, and have the capability of being set to zero. Saracione gives several examples of digital scales that can be utilized with the stereotaxic device: (1) the Mitutoyo scale uses capacitance and has a resolution of 0.5 microns; (2) the Anilam DRO that measures by optoelectronic scanning and has resolution less than 5 microns. (product information provided by websites [www.anilam.com](http://www.anilam.com) and [www.mitutoyo.com](http://www.mitutoyo.com) )

Kynast discloses a stereotaxic frame that has a moveable instrument connected to the frame for performing a surgical operation. The change in position of the

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instrument is measured by a linear translation device 110 (column 4, line 44 to column 5, line 80). Kynast teaches that the signal from the measuring device 110 can be visually displayed on a display element 124 separate from and moveable to the measuring device, such as a computer, CRT, flat screen LCD, or other analog or digital display. Bell discloses another device (12) that manipulates a probe (14) in three dimensions. Bell utilizes reader heads associated with each axis to take measurements, which are then transferred to a digital display (18) that shows the position of the tool along each axis independently (column 2, lines 42-47 and column 4, lines 10-21). Since it was known in the art at the time the invention was made to use a digital display device that has a location separate from the manipulator and reader heads, it would have been obvious to one of ordinary skill to connect the reader heads of the Saracione device to a separate display device.

Regarding claims 11, 12, 21, and 22: the device only needs to be capable of allowing these functions. The modified device of Saracione is capable of allowing continuous observation and video monitoring of a procedure.

### ***Response to Arguments***

5. Applicant's arguments filed 8/31/04 have been fully considered but they are not persuasive. Applicant argues that it is not known in the art to use a separate display box for displaying readouts from reader heads. It was determined that it is well known to use a separate display box in conjunction with reader heads, so it would be obvious to apply this technology to the Saracione stereotaxic holder.

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**Conclusion**

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US Patent No. 3,768,094 to Henrich shows that it is well known in the art to display measurements on a separate digital readout box.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sarah K Webb whose telephone number is (703) 605-1176. The examiner can normally be reached on Mon-Fri 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhhuan T. Nguyen can be reached on (703) 308-2154. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SKW  
10/28/04



**JULIAN W. WOO**  
**PRIMARY EXAMINER**